REMARKS

Reconsideration of this application as amended is respectfully requested.

In the Office Action, claims 1-30 were pending and rejected. In this response, no claim has been canceled. Claims 1, 14, and 28-30 have been amended. No new matter has been added.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,832,726 to Torchalski ("Torchalski"), in view of U.S. Patent No. 5,431,288 to Nishijima, et al., ("Nishijima"). In view of the foregoing amendments, it is respectfully submitted that claims 1-30 as amended are patentable over the cited references.

Specifically, for example, independent claim 1 recites as follows:

> 1. A method, comprising:
>   capturing an original machine-readable code (MRC) at a location of a document;
>   generating a new MRC based on the captured original MRC, the new MRC representing the same data of the original MRC, <u>the new MRC and the original MRC having an identical format</u>; and
>   <u>replacing</u> the original MRC with the new MRC to <u>generate an electronic version of the document having the new MRC and a remainder of contents of the document</u>, wherein the new MRC is located at substantially the <u>same location as the original MRC with respect to the remainder of the contents of the document</u>.

(Emphasis added)

Independent claim 1 requires generating a new MRC from an original MRC and replacing the original MRC with the new MRC at the same location of a document with respect to the rest of the content of the document to generate an electronic version of the document, where the new and original MRCs have the same format. That is, after scanning an original document (e.g., a physical document) having an original MRC, processing logic generates a new MRC based on the original MRC, where the new MRC has the same format

as the original one (e.g., both original MRC and new MRC are in a barcode format). The new

MRC replaces the original MRC when generating an electronic version of the original

document at the same location of the original MRC. Therefore, the electronic version of the

document includes the new MRC and the remaining content of the original document, but

without the original MRC. It is respectfully submitted that the above limitations are absent

from the cited references.

Rather, Torchalski is related to a software package that can scan an existing printed

label into a memory where a user can generate a label format that can be used to print it out on

a label subsequently (see Abstract and Summary, col. 3, lines 21 to 46 of Torchalski).

Specifically, Torchalski states:

> "As described, the method (and computer software package) provides that a
> label format can be created by scanning an existing, printed label. As such, a user can
> easily import existing label formats that were not created using a given software
> package (or a compatible package), such as printer labels which were created in a
> printer-specific command language. Hence, the user does not have to manually create a
> similar label format from scratch, manually interpreting and measuring the different
> features and characteristics of the label."

(Torchalski, Fig. 1; col. 4, lines 45-54, emphasis added)

Thus, Torchalski is not related to replacing an existing machine readable code located

at a location of a document (e.g., in view of the rest of the content of the document) with a

new machine readable code of the document. Rather, Torchalski is related to scanning an

existing label and storing it as a template in a memory, where the scanned label can be printed

from the memory subsequently.

In contrast, the present invention as claimed is related to scanning a document,

locating and capturing an original MRC within the scanned document, generate a new MRC

based on the captured original MRC, and replacing the original MRC with the new MRC at

the same location of the document (e.g., same document). As a result, even if the original

MRC were faded out in the ordinary usage, when the document containing the original MRC is scanned (e.g., copied), the original MRC is automatically located and captured to generate a new MRC. When the document is printed (e.g., via the copy machine), the new MRC is printed on the same location as the original MRC on the document, replacing the original MRC.

Nishijima is related to a mail sorting system that will convert a mailing address into a barcode and then print the barcode on a blank area of the envelope, such that the mail item can be sorted later by scanning the barcode. See, for example, Nishijima, Abstract; Fig. 1; col. 2, line 33 to col. 3, line 20. That is, Nishijima is not designed to replace an old machine readable code with a new machine readable code such as a barcode, where the old and new machine readable codes have the same format.

It is respectfully submitted that one with ordinary skill in the art would not consider a mailing address printed as letters or characters as machine readable codes. Specifically, Nishijima requires a character recognition section to recognize the mailing address and to quantize the recognized characters (see, e.g., col. 3, lines 3-20 of Nishijima). Thus, a mailing address is not a machine readable code. Otherwise, such a conversion from a mailing address to a barcode would not be needed.

Even if, for the sake of the argument, the mailing address of Nishijima may be considered as a machine readable code; however, the new code and the mailing address are not in the same format as required by the independent claim 1 of the present application.

Further, the mail sorting system of Nishijima is not designed to replace the mailing address with the new barcode. Rather, the system of Nishijima is designed to convert the mailing address into a barcode and to print the barcode on a blank area of the mail item, in addition to the mailing address. See, for example, Nishijima, col. 3, line 64 – col. 4, line 27.

Thus, the _mailing address and the barcode co-exist_, which appears to teach away from the present invention as claimed.

In addition, there is no disclosure or suggestion within Torchalski and Nishijima to combine with each other. Here Torchalski is related to scan a label into a computer as a template for future editing and printing a label having a similar layout of the original scanning label. Nishijima's design is to print a barcode represent a mailing address, in addition to the mailing address, for sorting purposes. Since each mailing address is unique and there is no need to store the mailing address and/or barcode associated with the mailing address for future use. Once the sorting operations are completed, the generated barcode for the mailing address is almost useless and there is no need to store it into a computer as a template. It is respectfully submitted that one with ordinary skill in the art, based on the teachings of Torchalski and Nishijima, to combine these two references because such a combination lacks reasonable expectation of success.

Furthermore, even if Torchalski and Nishijima were combined, such a combination still lacks the limitations set forth above. Therefore, for the reasons discussed above, it is respectfully submitted that claim 1 is patentable over Torchalski and Nishijima.

Similarly, independent claims 14 and 28-30 include limitations similar to those recited in claim 1. Thus, for the reasons similar to those discussed above, independent claims 14 and 28-30 are patentable over Torchalski and Nishijima.

Given that the rest of the claims depend from one of the above independent claims, at least for the reasons similar to those discussed above, it is respectfully submitted that the rest of the claims are patentable over Torchalski and Nishijima. Withdrawal of the rejections is respectfully requested.

In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: ___February 5, 2007___

Kevin G. Shao
Attorney for Applicant
Reg. No. 45,095
Kevin_Shao@bstz.com

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026
(408) 720-8300